

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

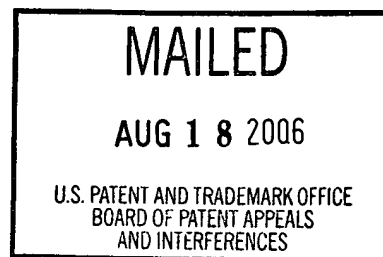
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RANDALL R. SCHNIER

Appeal No. 2006-0979
Application No. 08/818,185

ON BRIEF



Before JERRY SMITH, RUGGIERO and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, 11, 15-36 and 39. Claims 10, 12-14, 37 and 38 have been canceled.

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The disclosed invention pertains to a bootstrapping technique for distributed object client systems.

Representative claims 28 and 33 are reproduced as follows:

28. A program product comprising:

(A) an applet, said applet being used to retrieve an object reference for a naming context object from a server apparatus; and

(B) signal bearing media bearing said applet.

33. An apparatus comprising:

at least one processor;

a memory coupled to the at least one processor;

a server system, said server system comprising:

a) at least one object server, said at least one object server including a naming context object;

b) a web server, said web server having access to a stringified object reference for said naming context object, wherein said web server downloads said stringified object reference to a web browser when said stringified object reference is requested by said web browser.

The examiner relies on the following references:

Tang et al. (Tang)	5,793,365	Aug. 11, 1998 (filed Jan. 2, 1996)
Hamilton et al. (Hamilton)	6,009,464	Dec. 28, 1999 (filed Oct. 16, 1995)

Kessler et al. (Kessler), "JavaOne '96 Presentations,"
www.javasoft.com/javaone/javaone96/pres/, pages 1-23.

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The examiner relies on the following references to support the taking of official notice:

Cheng et al. (Cheng)	5,873,092	Feb. 16, 1999 (filed Dec. 14, 1995)
Phillips et al. (Phillips)	6,151,637	Nov. 21, 2000 (filed Sep. 4, 1996)

The following rejections are on appeal before us:

1. Claims 1-4, 6, 7, 9, 11 and 15-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view of Kessler, and further in view of the examiner's taking of Official Notice, relying upon Cheng and Phillips.

2. Claims 5, 8, 33-36 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamilton in view of Kessler, and further in view of Tang.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived. See 37 CFR § 41.37(c)(1)(vii) (2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejection of claims 1-9, 11, 15-36 and 39. Accordingly, we reverse.

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We consider the obviousness of the following logical groups of claims, as defined under separate subheadings [brief, page 6] and argued separately by appellant in the brief:

GROUP I: Claims 1-9, 11, and 15-32 [brief, page 8].

GROUP II: Claims 33-36 and 39 [brief, page 12].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on

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evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined

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on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

GROUP I, claims 1-9, 11 and 15-32

I. We consider first the examiner's rejection of the claims in Group I. We note that the examiner has rejected claims 1-4, 6, 7, 9, 11 and 15-32 as being unpatentable over Hamilton in view of Kessler, and further in view of the examiner's taking of Official Notice, relying upon Cheng and Phillips. However, the examiner has rejected claims 5 and 8, also within Group I, as being unpatentable over Hamilton in view of Kessler, and further in view of Tang. Pursuant to our authority under 37 CFR § 41.37(c)(1)(vii)(2004), we will select independent claim 28 as the representative claim because it is the broadest independent claim in Group I.

Appellant notes that the independent claims in Group I (i.e., claims 1, 7, 21 and 28) recite the basic concept of delivering an object reference for a Naming Context Object (NCO) to a client after that client has contacted or requested the object reference from a server [brief, page 8]. Appellant argues that this feature is not disclosed or suggested by the combination of

Hamilton and Kessler, nor by any of the other references cited by the examiner [*id.*]. Appellant asserts that Hamilton and Kessler disclose essentially the same subject matter as a number of other prior art references utilized by the examiner in previous Office Actions [*id.*].

Appellant asserts that the examiner is focusing on the language in these references related to obtaining object references from a Naming Context Object, rather than obtaining an object reference for the Naming Context Object itself, which is the subject of the Group I claims [brief, page 9, emphasis added]. Appellant further asserts that the cited references all discuss, at most, how a Naming Context Object is used to obtain object references for other objects [*id.*]. Appellant notes that this is the well known purpose of a Naming Context Object [*id.*]. Appellant argues that the references do not disclose precisely how an object reference for the Naming Context Object is obtained for the purpose of retrieving a proxy object for the NCO, whereby the proxy object facilitates further usage of the NCO in a standard CORBA environment [*id.*]. Appellant concludes that none of the passages in Hamilton cited by the examiner disclose delivering an object reference for a Naming Context Object to a "zero install client" after the "zero install client" has contacted a server, contrary to the examiner's assertion [*id.*].

In response, the examiner argues that Hamilton, as modified by Kessler, teaches a method and apparatus for enabling application programs (e.g., a web browser) to invoke objects within network servers that have different network protocols, e.g., a document server downloads Object Request Brokers (ORBs) and network protocols to application programs, thus enabling application programs to invoke objects within network servers, as taught by Hamilton at col. 2 line 40 through col. 3, line 25; col. 7, lines 3-52 and col. 9, lines 25-35 [answer, page 8]. The examiner notes that Kessler teaches a Java ORB which provides a "zero install client" [answer, page 9]. The examiner concludes that it is obvious that the prior art teaches the process of obtaining the Interface Definition Language (IDL) object reference for the "zero install client" [*id.*].

At the outset, we note that to reach a proper conclusion under § 103, the examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the examiner to ascertain whether the examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to

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a person of ordinary skill in the art. We note that to establish a *prima facie* case of obviousness, the examiner must meet three basic criteria: Firstly, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Rouffet, 149 F.3d 1350, 1355-57, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Secondly, there must be a reasonable expectation of success. Medchem S.A. v. Rolabo, S.L., 437 F.3d 1157, 1165 77 USPQ2d 1865, 1870 (Fed. Cir. 2006); In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Finally, the prior art references when combined must teach or suggest all the claim limitations. In re Gulack, 703 F.2d 1381, 1385 n. 9, 217 USPQ 401, 403 n. 9 (Fed. Cir. 1983); In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). (obviousness requires a suggestion of all limitations in a claim).

We note that the relevant portion of instant claim 28 recites: “an applet, said applet being used to retrieve an object reference for a naming context object from a server apparatus” [claim 28, emphasis added]. We note that Hamilton teaches that application program 510 may only be given a logical name for the network server and, in order to find the network server machine within which network server 570 resides, application program 510 refers to network name server 540 to find the particular

network server machine address [col. 7, lines 6-14]. We further note that Hamilton teaches that once application program 510 has located the network server machine, it refers to object name server 560 to find a reference to network server 570 [col. 7, lines 15-18]. Thus, we find that Hamilton merely teaches that a network name server may be accessed to obtain the machine address for a network server.

Significantly, we find that the combined teachings of the Hamilton and Kessler references do not support the examiner's finding, as set forth in the rejection, that an object reference is retrieved (i.e., delivered) for a Naming Context Object, as claimed [answer, page 4, ¶1; see also instant claim 28]. We agree with appellant that the passages of Hamilton cited by the examiner are analogous to the well known use of a Naming Context Object to obtain an object reference for an object on a server, such that a proxy object can be obtained [brief, page 10].

With respect to the Phillips and Cheng references that the examiner has relied upon as support for the taking of Official Notice, we note that the examiner has failed to point out the specific portions of these references that support the examiner's contention. We find that Cheng merely teaches that an object name server implements one or more Naming Context Objects [col. 1, lines 53-54]. We find that Phillips merely teaches the use of Object Management Group (OMG) name binding where a "naming context" is

defined as an object that contains a set of "name bindings" in which each name is unique and every object has a unique object ID or reference [col. 8, lines 50-53]. We note that the appellant has conceded that it is well known for a Naming Context Object to be used to obtain object references for other objects [brief, page 9, ¶3]. However, we find that the use of a Naming Context Object to obtain object references for other objects fails to meet the language of the representative claim that specifically requires retrieving an object reference for a naming context object from a server apparatus [claim 28].

We further note that the examiner has failed to set forth a convincing line of reasoning to establish why an artisan would have been motivated at the time of the invention to combine the Hamilton and Kessler references with the examiner's finding that it is well known in the art that a Naming Context Object is located on the object name server [answer, page 4]. Accordingly, because Phillips and Cheng fail to make up for the deficiencies of Hamilton and Kessler, we will not sustain the examiner's rejection of representative claim 28. We note that each of independent claims 1, 7, 21, and 28 recites the equivalent limitation of retrieving (or "delivering" or "creating" and "downloading") an object reference for a Naming Context Object. We agree with appellant that this limitation is not fairly taught nor suggested by the references relied upon by the examiner. Because claims

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1-9, 11 and 15-27 and 29-32 stand or fall together with representative claim 28, we will also reverse the examiner's rejection of these claims.

GROUP II, claims 33-36 and 39

II. We next consider the examiner's rejection of claims 33-36 and 39 as being unpatentable over Hamilton in view of Kessler, and further in view of Tang. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii)(2004), we will select independent claim 33 as the representative claim for this group, because it is the broadest independent claim in Group II.

Appellant notes that Group II independent claims 33 and 34 add the concept of a "stringified object reference" being used as the format for the object reference for the Naming Context Object [brief, page 12]. Appellant further notes that these claims still recite in various forms the on-demand download of an object reference for a Naming Context Object to a web browser or applet executing therein [*id.*]. Appellant argues that Hamilton and Kessler do not disclose nor suggest this claimed feature [*id.*]. Appellant further argues that the Tang reference (which is relied upon to disclose the use of "stringified object references") also does not disclose or suggest this feature [*id.*].

In response, the examiner notes the prior art teaches the use of an Object Request Broker for handling object references and conversions between strings (i.e., "stringified object references") [answer, page 9]. The examiner further notes that the applications communicate with the ORB to convert and de-convert object references to "stringified object references" (Tang, col. 12, lines 40-60) [*id.*]. The examiner concludes that it is obvious that the ORB converts or formats "stringified object references" as a format for the object reference and for use by the ORB naming service [*id.*].

We agree with the examiner that Tang teaches the use of "stringified object references" and associated conversions between strings and object references [Tang, col. 12, lines 46-60]. However, we do not agree with the examiner that the combination of Hamilton, Kessler, and Tang meets the language of the representative claim that specifically requires: "a web server, said web server having access to a stringified object reference for said naming context object, wherein said web server downloads said stringified object reference to a web browser when said stringified object reference is requested by said web browser" [claim 33, emphasis added]. We agree with appellant that this limitation is not fairly taught nor suggested by the references relied upon by the examiner. Therefore, we will not sustain the examiner's rejection of representative claim 33 for essentially

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the same reasons argued by the appellant in the brief. Because claims 34-36 and 39 stand or fall together with representative claim 33, we will also reverse the examiner's rejection of these claims.

In summary, we agree with appellant that the examiner has failed to meet his/her burden of presenting a *prima facie* case of obviousness. Therefore, we will not sustain the examiner's rejection of any of the claims on appeal. Accordingly, the decision of the examiner rejecting claims 1-9, 11, 15-36 and 39 is reversed.

Lastly, we note that "signal bearing media" is recited in independent claims 21 and 28. We further note that the support found in the instant specification broadly encompasses "transmission type media such as digital and analog communication links," thus appearing to encompass a signal encoded with functional descriptive material [instant specification, page 21, ¶1]. We note that under the PTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" [OG, 22 Nov. 2005], a claim reciting a signal encoded with functional descriptive material does not appear to fall within any of the categories of patentable subject matter set forth in §101. Accordingly, we leave it to the examiner to consider whether a rejection under 35 U.S.C. § 101 is appropriate for instant claims 21-32.

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REVERSED

Jerry Smith

Jerry Smith
Administrative Patent Judge

Joseph F. Ruggiero

Joseph F. Ruggiero
Administrative Patent Judge

Jean R. Homere

Jean R. Homere
Administrative Patent Judge

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